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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,750	12/12/2003	Jean Cotteret	LORE:004US	9530
7590	03/10/2006		EXAMINER	
Mark B. Wilson Fulbright & Jaworski L.L.P. Suite 2400 600 Congress Avenue Austin, TX 78701			ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/734,750	Applicant(s) COTTERET ET AL.	
	Examiner Eisa B. Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 27-40 and 43-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,22-26,41 and 50-64 is/are rejected.
- 7) ☒ Claim(s) 9 and 12-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This action is responsive to the applicant's election received by the office on February 27, 2006. Election of claims 1-26, 41-42 and 50-64 is acknowledged. Claims 27-40 and 43-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected claimed species. Therefore, claims 1-26, 41-42 and 50-64 are pending in this application.

Claim Objections

2 Claims 41-42 objected to because of the following informalities:

 The claims recite the term "preferably chosen from". This term should be replaced by the term "selected from the group consisting of" to make the claims in the proper form. Appropriate correction is required.

3 The examiner makes of record that claims 51, 56 and 59 recite a broad range of percentages followed by a narrow percentage range. For examination purposes, the examiner asserts that the narrow ranges recited in the instant claims 51, 56 and 59 are merely exemplary ranges, and thus, the prior art will be applied against the broadest ranges recited in the claims 51, 56 and 59. Further, the examiner suggests that applicant should delete the narrow ranges from the instant claims 51, 56 and 59, and add new dependent claims that recite the narrow ranges recited in the instant claims 51, 56 and 59. Furthermore, the examiner suggests that applicant should delete the narrow limitation of the component recited in claim 62 "preferably hydrogen peroxide" and add new dependent claim that recites the limitation of the component recited in claim 62.

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-11, 22-26, 41 and 50-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1).

Lim et al. (US' 391 B1) teaches a hair dyeing composition comprising oxidation base of cationic tertiary para-phenylenediamine having a formula (1), which is similar to the claimed formula (1), when in the reference formula (1), R, R1 and R2 are alkyl radicals, R4 is hydrogen atom or an alkyl radical and R5 is a hydrogen atom as claimed in claims 1-8 and 10-11 (see col. 2, lines 44-50) and when in the claimed formula (1), R2 represents the onion radical Z of the claimed formula (II), R3 is a hydrogen atom, n is 1 or 0 and R1 is an alkyl radical.) and 6-methoxy 2,3-diaminopyridine as claimed in claims 1 and 41 (see col. 5, line 62). Lim et al. further, teaches the compounds 1-(4-aminophenyl)-N,N-dimethyl-N-pentylpyrrolidin-3-ammonium iodide and 1-(4-aminophenyl)-N-(2-hydroxyethyl)-N,N-dimethylpyrrolidin-3-ammonium iodide which are structurally similar to the claimed compounds as claimed in claims 22-26 (see col. 19, Example 22 (compound 7) and col. 26, Example 29 (compound 14). The cationic tertiary para-phenylenediamine is represented in the amount of 0.01 to about 5.0%, which is within the claimed range as claimed in claim 51 (see col. 3, lines 43-46, cationic polymers such as cationic resins as claimed in claim 52 (see col. 8, line 57), thickening polymers as claimed in claim 53 (see col. 8, line 45), surfactants such as anionic surfactants as claimed in

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claim 54 (see col. 8, line 23), additional oxidation bases such as paraphenylenediamine and couplers such as m-phenylenediamines as claimed in claims 55, 57 and 58 (see col. 5, line 66 and col. 7, line 64), wherein the primary intermediates (oxidation bases) and the couplers are used in equivalent amounts in the range of 0.001 to about 10 which within the claimed ranges as claimed in claims 56 and 59 (see col. 7, lines 8-15), wherein the composition further comprises direct dyes as claimed in claim 60 (see col. 7, line 20-54), hydroxylated solvents such as ethanol as claimed in claim 61 (see col. 8, line 15), oxidizing agent of hydrogen peroxide as claimed in claim 62 (see col. 9, line 66). Lim et al. (US' 391 B1) also teaches a similar process for dyeing hair as claimed in claim 63 (see col. 9, lines 60-65).

Although Lim et al. (US' 391 B1), teaches a cationic tertiary para-phenylenediamine containing pyrrolidine ring as an oxidation base and heterocyclic couplers such as 2,3-diaminopyridines, the reference does not require such a hair dyeing composition comprising the cationic tertiary para-phenylenediamine containing pyrrolidine ring in a combination with the 2,3-diaminopyridine couplers with sufficient specificity to constitute anticipation.

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to formulate such a dye composition as taught by Lim et al. (US' 391 B1) which contains the coupler 2,3-diaminopyridine in a combination with the oxidation base of a cationic tertiary para-phenylenediamine containing pyrrolidine ring because such hair dyeing compositions fall within the scope of those taught by Lim et al. (US' 391 B1). Therefore, one of ordinary skill in the art would have had a reasonable expectation of success, because such a hair dyeing composition containing the coupler of 2,3-diaminopyridine in a combination with the

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oxidation base of a cationic tertiary para-phenylenediamine containing pyrrolidine ring is expressly suggested by the Lim et al, disclosure and therefore, is an obvious formulation.

With respect to claim 64, it would have been obvious to one having ordinary skill in the art at the time the invention was made to separate the oxidation dyeing composition by using a multicompartment device because Lim et al. (US' 391 B1) clearly teaches that the dyeing composition is mixed with the oxidizing composition immediately prior to use (see col. 9, lines 60-64) which implies that the dyeing composition is kept in a separate container or device and the oxidizing composition is kept in another separate device, and, therefore, it is an obvious formulation.

Further, the applicants have not shown on record the criticality of cationic tertiary para-phenylenediamine containing pyrrolidine ring in a combination with the 2,3-diaminopyridine couplers in the dyeing composition of the claimed invention.

5 Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Konrad et al. (US 4,661,114).

The disclosure of Lim et al. (US' 391 B1) as described above, does not teach or disclose the claimed couplers of 3-amino-5-hydroxypyridines as claimed.

However, Lim et al. (US' 391 B1) suggests the use of heterocyclic couplers of pyridine compounds in the hair dyeing composition (see col. 5, lines 61-62 and col. 6, line 40).

Konrad et al. (US' 114) in analogous art of hair dyeing formulation, teaches a composition comprising the claimed coupler species 3-amino-5-hydroxy-2,6-dimethoxypyridine and 3-amino-5-hydroxy-2,6-di-(2'-hydroxyethoxy)pyridine as claimed in claim 42 (see col. 2, lines 12-15).

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Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the dyeing composition of Lim et al. (US' 391 B1) by incorporating the coupler species 3-amino-5-hydroxy-2,6-dimethoxypyridine and/or 3-amino-5-hydroxy-2,6-di-(2'-hydroxyethyloxy)pyridine as taught by Konrad et al. (US' 114) to make such a composition. Such a modification would be obvious because Lim et al. (US' 391 B1) as a primary reference clearly suggests the use of heterocyclic couplers include pyridine derivatives. Konrad et al. (US' 114) as a secondary reference teaches the claimed species 3-amino-5-hydroxy-2,6-dimethoxypyridine and 3-amino-5-hydroxy-2,6-di-(2'-hydroxyethyloxy)pyridine, and, thus, a person of the ordinary skill in the art would be motivated to incorporate these couplers as taught by Konrad et al. (US' 114) in the dyeing composition of Lim et al. (US' 391 B1) with the reasonable expectation of success for obtaining a hair coloration which is a good fastness to light, permanent waving, acid and rubbing and would expect such a composition to have similar properties to those claimed, absent unexpected results.

Allowable Subject Matter

6 Claims 9 and 12-21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record do not teach or disclose the limitations of these claims.

Conclusion

7 The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the

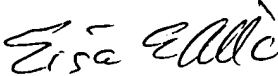
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rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eisa Elhilo
Primary Examiner
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March 8, 2006